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Fulwider Patton LLP
Howard Hughes center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045

EXAMINER

EREZO, DARWIN P

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3773

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/829,019	Applicant(s) GANNOE ET AL.	
	Examiner Darwin P. Erez	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-15, 17-19, 26, 28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7/19/04, 9/27/04, 2/14/05 and 10/16/06 .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Species I in the reply filed on 6/20/08 is acknowledged. The traversal is on the ground(s) that Species II is not mutually exclusive from Species I and should be generic to Species I. This is found persuasive and the election requirement for Species II is withdrawn.
2. Claim 16 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/20/08.
3. Furthermore, claim 27 is also withdrawn because it is not directed towards the elected Species I (staple) of the restriction requirement mailed on 2/5/08.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

4. The information disclosure statement(s) (IDS) submitted on 7/19/04, 9/27/04, 2/14/05 and 10/16/06 have been received and made of record. Note the acknowledged forms PTO-1449 enclosed herewith.
5. Applicant should note that the large number of references in the attached IDS have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. **See MPEP 609.05(b)**. Applicant is requested to

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point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

Drawings

6. New corrected drawings in compliance with 37 CFR 1.84(l) are required in this application because the drawing contains lines, numbers & letters that are not uniformly thick and well defined (poor line quality). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

7. The "CROSS-REFERENCE TO RELATED APPLICATIONS" section needs to be updated to provide the current status for application 10/188,547.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-10, 13-15, 17-19, 26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,954,731 to Yoon.

Yoon tissue acquisition device, comprising: an elongate main body 16 having a proximal end, a distal end, and a length therebetween; a first jaw member 18a and a

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second jaw member 18b each pivotally connected to the distal end of the main body, wherein the first and the second jaw members are adapted to move from a first configuration (Fig. 3B) to a second expanded configuration (Fig. 8) in which the jaw members are translationally positioned into apposition with each other, and wherein the first and the second jaw members each define an opening in fluid communication with lumens 130a, 130b defined in the main body; wherein the main body defines additional lumens 22c, 22d (see Fig. 4), which can receive an endoscope 26 that is viewable as a wire that is capable of reinforcing the main body; wherein the device has pull wire or push rod 116a, 116b for articulating the device; wherein the device has a handle (Fig. 2); wherein the first and second jaw members are connected to the main body via crescent shaped hinges (Fig. 8, the location at 118a, 118b); wherein the openings are at 180 degrees apart (see Fig. 4); wherein the jaw members 18a and 18b each have additional structures (112a, 114a and 112b, 114b) that can be interpreted as guide rods; wherein the device further comprises a fastening assembly 190 with a fastening element comprising a staple (a clip has an identical structure to a staple), which assists in tissue healing, wherein the opening is a fenestration (opening in a surface).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 11, 12 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,954,731 to Yoon in view of WO 00/54662 to Marucci et al.

Yoon discloses all the limitations of the claims except of the length or depth of the opening, or the opening comprising a plurality of fenestrations. However, Marucci discloses that it known in the tissue grasping art to have a plurality of openings/perforations/fenestrations along the surface of the jaw member to be utilized as a additional means of grasping tissue via suction (page 10, lines 25-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

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was made to modify the device of Yoon to have the plurality of openings along the jaw members because it would provide an additional means of grasping the tissue. With regards to the length and depth of the openings, one of ordinary skill in the art would have found it obvious to arrive at the recited limitations since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955)) and it has also been held that discovering an optimum value of a result effective variable involves only routine skill in the art (*In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erez/
Primary Examiner, Art Unit 3773